

**REMARKS**

In accordance with the foregoing, the specification and claims 1, 4, 8, 10, 12, 15, 19 and 21 have been amended. No new matter is presented in the foregoing amended specification and amended claims 1, 4, 8, 10, 12, 15, 19 and 21 and, accordingly, approval and entry of same are respectfully requested.

**STATUS OF CLAIMS**

Claims 1-22 are pending and under consideration.

Claims 1-4, 8-15 and 19-22 are rejected.

**ALLOWABLE SUBJECT MATTER**

Claims 5-7 and 16-18 are objected to but are indicated to be allowable if suitably rewritten to be dependent upon a rejected base claim or if rewritten to independent form including all the limitations of the respective base and any intervening claims.

**ITEM 1: OBJECTION TO SPECIFICATION**

Responsive to Item 1, Applicant has amended the specification to correct the typographical errors noted in Item 1 of the Action. With respect to change (6), it is believed that the Examiner intended to refer to page 14, line 35.

**ITEM 2: OBJECTIONS TO THE DRAWINGS**

In accordance with the foregoing, a replacement drawing of FIG. 5 responsive to Item 2 is herewith submitted.

**ITEM 4: REJECTION OF CLAIMS 1-4, 8-9, 12-15 and 19-20 UNDER 35 U.S.C. §102(e) AS ANTICIPATED BY HATANAKA ET AL. (U.S. PATENT NO. 6,397,000);**

**ITEM 6: REJECTION OF CLAIMS 10-11 AND 21-22 FOR OBVIOUSNESS UNDER 35 U.S.C. § 103(a) OVER HATANAKA ET AL. (U.S. PATENT 6,397,000) IN VIEW OF YOSHIDA ET AL. (U.S. PATENT 2003/0120942)**

The rejections are respectfully traversed.

The Examiner relies upon Hatanaka et al., also, to reject all the independent claims of the present invention. However, it is respectfully submitted that Hatanaka et al. is not relevant to the present invention.

In the grounds of rejection of Item 4 as to independent claims 1 and 12, the Examiner cites Hatanaka et al., col. 7, lines 21-24, as disclosing that the video A/D converter 28, the audio A/D converter 29, the video encoder 30, the audio encoder 31 and the multiplexer 32 may be built together in the recoding/playback device 2 or in the digital broadcasting receiver 1. In this regard, in the Official Action at page 4, lines 9-10, the Examiner mentions that '(col. 7, lines 21-24 of Hatanaka et al.) illustrate that this embodiment provides a "coding/decoding part without storage" for 'the case where the given signal is output after being coded and decoded by said coding/decoding part without storage' of the present, claimed invention.

In this passage of Hatanaka et al., the embodiment provides an alternative hardware configuration - - i.e., whether or not the video A/D converter 28, the audio A/D converter 29, the video encoder 30, the audio encoder 31 and the multiplexer 32 is built together in the recording/playback device 2 or in the digital broadcasting receiver 1.

In contrast, according to the present invention, a different manner, i.e., 'setting a predetermined bit rate', is used in the case where reproduction is carried out without storing in a recording medium, from a manner in the case where reproduction is carried out after storing in the recording medium. Thus, according to the present invention, no alternative hardware configuration is provided, but the alternative processing manner is used. Thus, the configuration of the present invention is clearly different from that of Hatanaka et al.

As to the independent claims 4 and 15, Hatanaka et al. discloses switching between digital recording and analog recording in col. 8, lines 44-51, cited by the Examiner.

In contrast, according to the present invention, a bit rate is controlled.

Thus, the configuration of the present invention is clearly different from that of Hatanaka et al.

As to the independent claims 8 and 19, Hatanaka et al. discloses, in col. 8, lines 59-67, cited by the Examiner, to select one of analog playback and digital playback.

In contrast, according to the present invention, control is made whether the image signal is accessible.

Thus, the configuration of the present invention is clearly different from Hatanaka et al. - - and Hatanaka et al. is not relevant to the present invention.

Item 6 of the Action setting forth grounds for the §103 rejections merely contends for the alleged "obviousness to one of ordinary skill in the art..." of combining the "recording medium as taught by Yoshida et al. in the system of Hatanaka et al. in order to cut back user intervention to

record automatically...(etc.)....” This same contention of alleged obviousness is presented as well in the paragraphs spanning pages 7-8 of the Action. It is submitted that these bare contentions are insufficient.

#### **LACK OF *PRIMA FACIE* OBVIOUSNESS OF THE COMBINATION OF REFERENCES RELIED UPON**

It is submitted that the Action fails to satisfy the requirement of a *prima facie* demonstration of obviousness of the combination and, instead, relies on the discredited bare contention that the combination “would have been obvious to one of ordinary skill in the art....” Moreover, motivation to effect the combinations is not supported by the Examiner’s suggestions. See MPEP 706.02(j), which emphasizes that the Examiner should set forth in the Office Action: (A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate, (B) the difference or differences in the claim over the applied reference(s), (C) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and (D) an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria.

#### **CONCLUSION**

It is respectfully submitted that the foregoing has patentably distinguished the pending claims over the references and rejections of record. Further, all outstanding objections have been overcome by the foregoing. There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

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If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

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